

REMARKS

By this amendment, claims 1-42 are pending, with claims 1-16 and 42 being withdrawn from consideration by the Examiner in response to a prior restriction election by Applicant of Group II. Elected claims 17-41 (Group II) are being examined. Claims 17, 31 and 35-37 are amended herein to better clarify the claimed invention. Specifically, claim 17 and 31 have been amended to overcome a rejection under 35 U.S.C. §§ 101 and 103(a). Claim 35 has been amended to overcome a rejection purportedly under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 103(a). No new matter is believed to be added by these Amendments. In view of the above amendments and the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Rejections Under 35 U.S.C. § 101

Claims 17-34 stand rejected under 35 U.S.C. § 101 “because the claimed invention is directed to non-statutory subject matter.” Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 17 has been amended to specify, in part: “computer-implemented,” and “wherein the providing, prompting, computing and outputting steps are performed by a computer.” Independent claim 31 has been amended to include “wherein each of the providing and generating steps execute on a computer platform.”

Applicants submit that the process recited by these amended claims cannot be performed by a mental process alone. Moreover, claims 17 and 31, and their dependent

claims, are tied to another statutory class. Moreover, a transformation is accomplished at least in the step of computing. Therefore, Applicants submit that the U.S.C. § 101 rejections of claims 17-34 should now be withdrawn.

Rejections Under 35 U.S.C. § 112

Claims 35-39 stand rejected under 35 U.S.C. § 112 as being allegedly “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Applicants respectfully traverse this rejection for at least the following reasons.

The Office Action states that: “[a] system or an apparatus should always claim the structure or the hardware that performs the function” [at 4]. Applicants disagree with the Examiner’s statement and respectfully directs the Examiner to section 2173.05(g) of the MPEP where functional language is specifically discussed and explained as being permissible. However, Applicants suspect that the Examiner may have meant to base comments instead on 35 U.S.C. 112, sixth paragraph, and not the second paragraph. Believing this may be the case, and to further progress of the application, Applicants have amended claims 35-37 to rephrase these claims. Support for the amendments to claims 35-37 may be found at least at [0039] in view of Figure 7.

Applicants respectfully submit that the 35 U.S.C. 112 rejection should now be withdrawn.

Rejections Under 35 USC § 103

Claims 17-19, 22-31, and 33-41 stand rejected under 35 U.S.C 103(a) as being unpatentable by JD Power and Associates Report (“JD Power”), in view of U.S. Patent No. 6,449,766 to Fleming (“Fleming”). Claims 20-21 and 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable by JD Power and Associates Report in view of Fleming, U.S. Patent No. 6,449,766 further in view of U.S. Pub. No. 2005/0086530 to Goddard (“Goddard”). Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant’s disclosure. *See in re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Applicants submit that the references of record, whether taken singly or

taken in combination, fail to disclose or suggest all the claimed limitations.

Amended independent claims 17 and 31 each recite, in part:

providing predetermined attractiveness scores associated with one or more product attributes and one or more age brackets for a product, wherein the providing occurs prior to a market introduction of the product. (Emphasis added)

Amended independent claim 35 recites, in part:

a first component embodied in a storage medium to provide predetermined attractiveness scores associated with one or more product attributes and one or more age brackets for a product, wherein the first component provides predetermined attractiveness scores prior to a market introduction of the product. (Emphasis added)

However, JD Powers is directed to a study of vehicles based on responses of 16,000 vehicle owners who rated their experiences with their vehicles. (JD Powers page 1, second full paragraph after “FOR IMMEDIATE RELEASE”). This is contrary to the claim language requirements of amended claims 17 and 31. In JD Powers, consumers are already owners of the product (vehicles). Therefore, attractiveness scores associated with one or more product attributes cannot be provided prior to market introduction of the product. Moreover, the consumers in JD Powers are creating essentially post-determined scores. Therefore, JD Powers does not disclose or suggest all the limitations of independent claims 17, 31 and 35. Fleming is directed to a multimedia system that includes a rating system such as MPAA or television rating system. However, Fleming fails to cure the deficiencies of JD Powers. Applicants submit that neither JD Powers, nor Fleming, whether taken alone or in combination, discloses or suggests all the

limitations of independent claims 17, 34 and 35, and that claims 17, 34 and 35 are allowable.

Applicants submit that those claims depending from independent claims 17, 31 and 35 are allowable at least because of their dependency. Moreover, no other document of record including Goddard supplies the missing features of JD Powers, whether taken singly or in combination.

Since none of the references discloses or suggests all the claimed limitations, whether taken singly or when taken in combination, Applicants submit that the claims 17-41 are allowable and that all the rejections under 35 U.S.C. 103(a) should now be withdrawn.

Support for Amendments

Support for the amendments to claims 17, 31 and 35 may be found at least at one of more paragraphs [0003] – [0005] where it discloses generally that there is currently no risk assessment system for general use during design and manufacturing when introducing products to market, i.e., prior to market introduction, for which the invention remedies, among other provided remedies. Also, support for the other amendment aspects to claims 17, 31 and 35 (and amendments to the claims depending from claim 35) may be found at least in Figure 7 and at [0039] and [0040].

Support for new Claims 43-45

Support for new claims 43-45 may be found at least at [0003]-[0005].

Conclusion

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



Charles J. Gross
Reg. No. 52,972

Date: May 26, 2009

McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
McLean, Virginia 22102-4215
Tel: 434.980.2229
Fax: 703.712.5194